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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,472	11/26/2003	Christopher L.R. Gickler	COS01032P1	8135

25537 7590 08/19/2005	EXAMINER
MCI, INC	TAYLOR, BARRY W
1133 19TH STREET NW	

ART UNIT	PAPER NUMBER
2643	

WASHINGTON, DC 20036

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No.	Applicant(s)
		10/721,472	GICKLER, CHRISTOPHER L.R.
		Examiner	Art Unit
		Barry W. Taylor	2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 July 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>26 November 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

PROTEST

1.   **The Examiner notes PROTEST filed in parent application 10/325,839 by**

John B. Mow (see paper dated 9/3/2004) declaring the methods described in both

applications (i.e. 10/325,839 and 10/325,839) were well known and utilized in the

industry for a long time prior to their filing dates and it has been common

practice by many facilities to run telephone numbers of their employees against

the inmate telephone calls to determine if there are inmate / employee

communications (i.e. fraternization) as early as the 1990s.

Information Disclosure Statement

2.   The information disclosure statements (IDS) submitted on 12/22/2003 and

2/28/05 have been entered and considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

3.   Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Brown et al (5,535,261 hereinafter Brown) in view of GAINSBORO (Pub. No.: US

2002/0071537) further in view of GAINSBORO et al (2001/0036821 hereinafter

Gainsboro-II).

Regarding claims 1 and 9. Brown teaches a method and system (figure 1)

comprising:

monitoring a plurality of communications (see abstract and figure 1 wherein

computer monitors telephone calls between correctional facilities (see TO CALLING

PHONES bottom right figure 1) and outside phone lines (see col. 3 lines 23-42 and

figure 2, col. 4 lines 19-24, col. 17 lines 4-12, col. 17 lines 36-40, col. 17 lines 51-56,

col. 18 lines 24-57, col. 19 lines 40-65));

comparing the plurality of monitored communications to information in a

database (see figures 1-2 wherein computer uses parameter and control file storage

module (item 114 figure 1) and program storage module (item 110 figure 1) to

determine if call is to be blocked or recorded (col. 2 line 45 – col. 3 line 60, col. 4 lines

19-24).

Brown fails to teach determining, based at least on the results of the comparing, if one or more of the plurality of communications indicate that an employee and inmate are fraternizing and performing a predetermined action if one of the plurality of communications indicates that the employee and inmate are fraternizing.

Gainsboro teaches a computer based method and apparatus for managing institutional telephone activity (abstract, paragraphs 0003 and 0008-0009) in order to detect illegal telephone activity. Gainsboro teaches inmate communications are monitored to detect security breaches (paragraphs 0008-009 and 0012) so that reports (paragraph 0013) and alarms (paragraph 0017) may be generated thereby allowing the system administrator the ability to cut off inmate calls on an individual or global basis (paragraphs 0031-0037).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Gainsboro into the teachings of Brown in order to detect illegal telephone calls.

According to Applicants, Gainsboro does not disclose or remotely suggest comparing a plurality of monitored inmate communications to information stored in a database (see bottom of page 10 and continuing to page 11, paper dated 7/15/05).

Gainsboro-II improves on an earlier filed application (see Related U.S. Application Data) wherein voice recognition is employed (abstract) so a comparison can be made to database to determine if criminal conspiracies or escapes attempts/plans are occurring (see at least paragraphs 0001 – 0005). Gainsboro-II discloses that calls

may be recorded only after a predetermined keyword is spoken (paragraphs 0009 –

0010) and compared to words stored in a central database (paragraphs 0020 - 0022).

Gainsboro-II discloses that all inmate calls are recorded, digitized and compared to

keyword database to determine if criminal conspiracy is about to occur or an escape is

being plotted (paragraphs 0025-0027).

It would have been obvious for any one of ordinary skill in the art at the time of

invention to utilize the teachings of Gainsboro-II into the teachings of Brown in view of

Gainsboro in order to automate the real-time recording of conversations to automatically

detect if inmates are participating in criminal conspiracies.

Regarding claims 2 and 10. Brown teaches wherein the predetermined action is

at least one of generates a report (see col. 17 lines 4-12 and Table 1 located on

columns 7-8 wherein "set_call_parameters 1269" used to generate record or alarm

based on numbers called) and sends notification to at least one entity (see col. 8 lines

53-60 and item 1307 in figure 13A wherein inmate is informed that he has dialed an

invalid number). Gainsboro also teaches generation of reports (see last line of

paragraph 0013) and notifying administrator when a particular inmate places a call or

calls a certain person (paragraphs 0017 and 0035).

Regarding claims 3-4 and 11-12. Brown fails to teach comparing data

associated with the communications determined as indicating that an employee and

inmate are fraternizing, to data in the suppression database wherein the report

highlights or omits any communications in which its associated data and the data in the suppression database match.

Gainsboro teaches a computer based method and apparatus for managing institutional telephone activity (abstract, paragraphs 0003 and 0008-0009) in order to detect illegal telephone activity. Gainsboro teaches inmate communications are monitored to detect security breaches (paragraphs 0008-009 and 0012) so that reports (paragraph 0013) and alarms (paragraph 0017) may be generated thereby allowing the system administrator the ability to cut off inmate calls on an individual or global basis (paragraphs 0031-0037).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Gainsboro into the teachings of Brown in order to detect illegal telephone calls.

Regarding claims 5 and 13. Brown teaches wherein the plurality of communications is at least one of one or more telephone calls (col. 3 lines 30-35, col. 4 lines 19-25).

Regarding claims 6 and 14. Brown teaches wherein the plurality of communications can be monitored at least one of locally (see figure 3A wherein system main window shows called numbers monitored (item 303) as well as, monitoring a location within the correction facility (i.e. locally---see 304 figure 3A and col. 10 lines 9-10).

Regarding claims 7 and 15. Brown teaches wherein at least one of a called number is monitored (see col. 4 lines 19-25 and item 303 in figure 3A wherein called numbers are monitored).

Regarding claim 8. Brown fails to teach a querying a database of logged monitored communications to determine potential fraternization between employees and the inmate.

Gainsboro teaches a computer based method and apparatus for managing institutional telephone activity (abstract, paragraphs 0003 and 0008-0009) in order to detect illegal telephone activity. Gainsboro teaches inmate communications are monitored to detect security breaches (paragraphs 0008-009 and 0012) so that reports (paragraph 0013) and alarms (paragraph 0017) may be generated thereby allowing the system administrator the ability to cut off inmate calls on an individual or global basis (paragraphs 0031-0037). Gainsboro further teaches querying a database (paragraph 0029).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Gainsboro into the teachings of Brown in order to detect illegal telephone calls.

Regarding claim 16. Brown fails to teach a query module configured to query a database of logged monitored communications to determine potential fraternization between the inmate and employees.

Gainsboro teaches a computer based method and apparatus for managing institutional telephone activity (abstract, paragraphs 0003 and 0008-0009) in order to

detect illegal telephone activity. Gainsboro teaches inmate communications are

monitored to detect security breaches (paragraphs 0008-009 and 0012) so that reports

(paragraph 0013) and alarms (paragraph 0017) may be generated thereby allowing the

system administrator the ability to cut off inmate calls on an individual or global basis

(paragraphs 0031-0037). Gainsboro further teaches querying a database (paragraph

0029).

It would have been obvious for any one of ordinary skill in the art at the time of

invention to utilize the teachings of Gainsboro into the teachings of Brown in order to

detect illegal telephone calls.

Regarding claim 17. Brown teaches an information storage media (figure 1)

comprising:

information that monitors a plurality of communications (see abstract and figure 1

wherein computer monitors telephone calls between correctional facilities (see TO

CALLING PHONES bottom right figure 1) and outside phone lines (see col. 3 lines 23-

42 and figure 2, col. 4 lines 19-24, col. 17 lines 4-12, col. 17 lines 36-40, col. 17 lines

51-56, col. 18 lines 24-57, col. 19 lines 40-65));

information that compares the plurality of monitored communications to

information in a database (see figures 1-2 wherein computer uses parameter and

control file storage (item 114 figure 1) and program storage (item 110 figure 1) to

determine if call is to be blocked or recorded (col. 2 line 45 – col. 3 line 60, col. 4 lines

19-24).

Brown fails to teach determining, based at least on the results of the comparing, if one or more of the plurality of communications indicates that an inmate and an employee are fraternizing and information that performs a predetermined action if one of the plurality of communications indicates that an inmate and an employee are fraternizing.

Gainsboro teaches a computer based method and apparatus for managing institutional telephone activity (abstract, paragraphs 0003 and 0008-0009) in order to detect illegal telephone activity. Gainsboro teaches inmate communications are monitored to detect security breaches (paragraphs 0008-009 and 0012) so that reports (paragraph 0013) and alarms (paragraph 0017) may be generated thereby allowing the system administrator the ability to cut off inmate calls on an individual or global basis (paragraphs 0031-0037).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Gainsboro into the teachings of Brown in order to detect illegal telephone calls.

According to Applicants, Gainsboro does not disclose or remotely suggest comparing a plurality of monitored inmate communications to information stored in a database (see bottom of page 10 and continuing to page 11, paper dated 7/15/05).

Gainsboro-II improves on an earlier filed application (see Related U.S. Application Data) wherein voice recognition is employed (abstract) so a comparison can be made to database to determine if criminal conspiracies or escapes attempts/plans

are occurring (see at least paragraphs 0001 – 0005). Gainsboro-II discloses that calls

may be recorded only after a predetermined keyword is spoken (paragraphs 0009 –

0010) and compared to words stored in a central database (paragraphs 0020 - 0022).

Gainsboro-II discloses that all inmate calls are recorded, digitized and compared to

keyword database to determine if criminal conspiracy is about to occur or an escape is

being plotted (paragraphs 0025-0027).

It would have been obvious for any one of ordinary skill in the art at the time of

invention to utilize the teachings of Gainsboro-II into the teachings of Brown in view of

Gainsboro in order to automate the real-time recording of conversations to automatically

detect if inmates are participating in criminal conspiracies.

Regarding claims 18 and 23. Brown teaches a device and method (figure 1)

comprising:

means for monitoring a plurality of communications (see abstract and figure 1

wherein computer monitors telephone calls between correctional facilities (see TO

CALLING PHONES bottom right figure 1) and outside phone lines (see col. 3 lines 23-

42 and figure 2, col. 4 lines 19-24, col. 17 lines 4-12, col. 17 lines 36-40, col. 17 lines

51-56, col. 18 lines 24-57, col. 19 lines 40-65));

means for comparing the plurality of monitored communications to information in

a database (see figures 1-2 wherein computer uses parameter and control file storage

(item 114 figure 1) and program storage (item 110 figure 1) to determine if call is to be

blocked or recorded (col. 2 line 45 – col. 3 line 60, col. 4 lines 19-24).

Brown fails to teach determining, based at least on the results of the comparing, if one or more of the plurality of communications poses a security threat and performing a predetermined action if one of the plurality of communications indicate that an inmate and an employee are fraternizing and performing a predetermined action if one of the plurality of communications indicates that the employee and inmate are fraternizing.

Gainsboro teaches a computer based method and apparatus for managing institutional telephone activity (abstract, paragraphs 0003 and 0008-0009) in order to detect illegal telephone activity. Gainsboro teaches inmate communications are monitored to detect security breaches (paragraphs 0008-009 and 0012) so that reports (paragraph 0013) and alarms (paragraph 0017) may be generated thereby allowing the system administrator the ability to cut off inmate calls on an individual or global basis (paragraphs 0031-0037).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Gainsboro into the teachings of Brown in order to detect illegal telephone calls.

According to Applicants, Gainsboro does not disclose or remotely suggest comparing a plurality of monitored inmate communications to information stored in a database (see bottom of page 10 and continuing to page 11, paper dated 7/15/05).

Gainsboro-II improves on an earlier filed application (see Related U.S. Application Data) wherein voice recognition is employed (abstract) so a comparison can

be made to database to determine if criminal conspiracies or escapes attempts/plans are occurring (see at least paragraphs 0001 – 0005). Gainsboro-II discloses that calls may be recorded only after a predetermined keyword is spoken (paragraphs 0009 – 0010) and compared to words stored in a central database (paragraphs 0020 - 0022). Gainsboro-II discloses that all inmate calls are recorded, digitized and compared to keyword database to determine if criminal conspiracy is about to occur or an escape is being plotted (paragraphs 0025-0027).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Gainsboro-II into the teachings of Brown in view of Gainsboro in order to automate the real-time recording of conversations to automatically detect if inmates are participating in criminal conspiracies.

Regarding claims 19 and 24. Brown fails to teach comparing data associated with the communications determined as indicating that an employee and inmate are fraternizing, to data in the suppression database.

Gainsboro teaches a computer based method and apparatus for managing institutional telephone activity (abstract, paragraphs 0003 and 0008-0009) in order to detect illegal telephone activity. Gainsboro teaches inmate communications are monitored to detect security breaches (paragraphs 0008-009 and 0012) so that reports (paragraph 0013) and alarms (paragraph 0017) may be generated thereby allowing the system administrator the ability to cut off inmate calls on an individual or global basis (paragraphs 0031-0037).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Gainsboro into the teachings of Brown in order to detect illegal telephone calls.

Regarding claims 20 and 25. Brown teaches wherein the predetermined action is at least one of generates a report (see col. 17 lines 4-12 and Table 1 located on columns 7-8 wherein "set_call_parameters 1269" used to generate record or alarm based on numbers called) and sends notification to at least one entity (see col. 8 lines 53-60 and item 1307 in figure 13A wherein inmate is informed that he has dialed an invalid number). Gainsboro also teaches generation of reports (see last line of paragraph 0013) and notifying administrator when a particular inmate places a call or calls a certain person (paragraphs 0017 and 0035).

Regarding claims 21 and 26. Brown fails to teach wherein the report highlights or omits any communications in which its associated data and the data in the suppression database match.

Gainsboro teaches a computer based method and apparatus for managing institutional telephone activity (abstract, paragraphs 0003 and 0008-0009) in order to detect illegal telephone activity. Gainsboro teaches inmate communications are monitored to detect security breaches (paragraphs 0008-009 and 0012) so that reports (paragraph 0013) and alarms (paragraph 0017) may be generated thereby allowing the system administrator the ability to cut off inmate calls on an individual or global basis (paragraphs 0031-0037).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Gainsboro into the teachings of Brown in order to detect illegal telephone calls.

Regarding claims 22 and 27. Brown teaches wherein at least one of a called number is monitored (see col. 4 lines 19-25 and item 303 in figure 3A wherein called numbers are monitored).

Response to Arguments

4.   Applicant's arguments with respect to claims 1, 9, 17, 18 and 23 have been considered but are moot in view of the new ground(s) of rejection.

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Friday, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached at (571) 272-7499. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Centralized Delivery Policy: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the central fax number **(571-273-8300).**

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